

REMARKS

Claims 1-24 are pending. No new matter has been added by way of the present amendments. For instance, claims 17-20 are supported by the present specification at, for example, page 14, lines 5-9, page 14, lines 10-30, and page 18, lines 27-32. New claims 21-24 are supported by originally filed claims 2, 5, 10 and 14 as well as the present specification at page 14, lines 5-9, page 14, lines 10-30, and page 18, lines 27-32. Accordingly, no new matter has been added.

The Examiner has maintained the rejection under 35 U.S.C § 112, first paragraph, which is traversed and addressed below:

Issues Under 35 U.S.C. § 112, First Paragraph

The Examiner has rejected claims 1-16 under 35 U.S.C. § 112, first paragraph, asserting that these claims fail to comply with the written description requirement. Applicants respectfully traverse.

The Examiner asserts that the specification fails to contain a written description of the processes as set forth in the claims wherein the last step of heating the non-stick sheet to drive the dry peel coating into the receptor element is not limited to hand ironing. The Examiner acknowledges that the present specification

incorporates the disclosure of the provisional application 60/013,193 which discloses processes encompassed by the instant claims, by incorporation by reference. However, the Examiner asserts that the provisional application does not disclose any heat press or generic heating for the last step of the instant claims of heating through the non-stick sheet. The Examiner acknowledges that the heat press is disclosed in the discussion of processes as using a hot peel without the step of peeling the image coating from its support prior to heating (by either heat press or hand ironing) as required by the instant claims. However, the Examiner asserts that in the process of the present claims the specification does not disclose the use of a heat press or generic heating in the last step.

Applicants respectfully disagree with the Examiner.

Contrary to the position taken by the Examiner, the process described on page 14, lines 10-30 is not limited in the manner described by the Examiner. For example, the paragraph immediately preceding the above-mentioned disclosure at page 14, lines 10-30 (e.g. see page 14, lines 8-9) is not limited to any one of the inventions disclosed in the specification. That is, it is preferred to exclude steam from any process of the invention.

Similarly, the discussion in the paragraph preceding the above-mentioned disclosure (at page 14, lines 8-9) is not limited to any one of the inventions disclosed in the specification (e.g. see page 14, lines 5-7). That is, imaging can be done with any copier or printer. Moreover, the discussion following the paragraph at page 14, lines 10-30 (e.g. see page 14, lines 31-33) is not limited to any one of the inventions disclosed in the specification. That is, the stated requirement for the transfer coating is generic to all of the disclosed inventions.

Accordingly, the disclosure at issue on page 14 is embedded within a description that is applicable to all of the disclosed inventions of the present application, including those currently claimed.

The Examiner has argued that the last step of the claimed invention using overlying non-stick sheets is recited in the specification for the express purpose of hand ironing. Applicants disagree. More accurately, page 14 of the specification teaches that hand-ironing is the preferred embodiment of the claimed invention. This is true since most consumers do not own heat presses at their homes. Page 14 indicates that the inventors observed the problem of incomplete transfers with hand-held irons.

The inventors came up with multiple solutions to this problem. The claimed peel-away process was one of the solutions to this problem.

The inventors recognized that one of the problems with conventional transfers was the requirement of ironing through a support sheet. Ironing through the support sheet prevented sufficient pressure to drive the imaged coatings deeply into the receptor. The present inventors recognized that the result was diminished washability and durability since the coatings were merely resting on the surface of the receptor (e.g. fabric) and not embedded therein. This problem was far more pronounced when a hand held iron was used. Thus, the invention was preferably directed to the home consumer.

The present invention found that removal of the coatings from the support prior to ironing and then placement of a tack free sheet on the imaged coating provided a process which was much more capable of driving the coatings into the receptor. The improvement resulted in a much softer and more durable image with the greatest commercial benefits being seen in the home market.

Therefore, by removing the support sheet, the inventors greatly improved the ability to transfer the image as compared to known process. The process was preferably applicable to the home consumer since the disadvantage of heating through the support was

more pronounced for the home consumer using a hand held iron. Since the incomplete transfer problem was much less severe with a heat press, the applicability of the process to the heat press market was less critical and thus less preferred economically. However, the process is still applicable to the heat press. Accordingly, the disclosure at page 14 is not limited to the ironing embodiment.

The Examiner has previously acknowledged that page 14 of the present specification addresses the problem of incomplete hand iron transfer. However, the Examiner is incorrect in asserting that the processes of the present claims do not include hand iron transfer from a support but rather stripping off the support from the transfer layer. Applicants admit that the claimed process first peels a film either before or after imaging from a support and prior to the application of heat in order to transfer the coating to the receptor. However, the invention claimed in the present application provides for a novel and non-obvious solution to the underlying problem of incomplete transfer observed by the inventors and referred to on page 14 of the specification.

Accordingly, the mode of heating (e.g. heating via heat-press or hand ironing in step (ii)) is not intended to be a limitation. The preference in the heating mode discussed on page 14 relates to

Applicants' perceived economic analysis in creating and expanding the home use market which was hampered by the incomplete transfer problem that was more pronounced when using a hand held iron. This does not mean that the invention was not applicable when used with a heat press. Thus, the discussion of "preferred" for home use was less a technical preference than a market driven economic preference.

Of course, for the home market where hand held irons around, the method of choice for heating is via ironing. This is simply true because most households do not have heat-press equipment. However, for those homes or businesses having heat presses, such heating devices may clearly be used since the actual mode of heating is simply not important to the claimed process. This is readily apparent to one of ordinary skill in the art.

The Examiner appears to be interpreting the present claims as excluding heat press. However, in fact, the phrase on page 14 states "preferably excludes ... heat press."

In summary, the Examiner states that the description on page 14 of the specification is not applicable to the claimed invention. Applicants respectfully disagree.

The discussion on page 14, lines 10-30 of the specification refers to the problem of incomplete transfer using conventional

products with conventional processes (i.e. using hand held irons). This problem underlies all of the inventions disclosed in the specification. One way Applicants solve these problems is via the claimed invention. However, due to the novel method of transfer, the mode of applying heat is not as critical as compared to prior art processes. Hand held irons in the present application are preferably used because home consumers possess them. Heat presses are less preferred in the present application because home consumers do not possess them. The Examiner should recall that the present application is preferably designed to solve problems faced by the home consumer. However, Applicants have not excluded solving similar problems when heat presses are used. Such problems are simply not believed to be as likely to occur with the same frequency when using the heat press. In any event, both devices are well known for applying heat in the heat transfer paper art.

More specifically, although page 14, lines 10-30 indicates that the process of the invention preferably excludes pressures attainable with commercially available heat press equipment, there is nothing improper by Applicant's claiming their non-preferred embodiments.

The Examiner should further note that the prosecution history of an application can be relied on for defining a term

for the requirements of 35 U.S.C. § 112. See All Dental Prodx, LLC v. Advantage Dental Prods., Inc., 64 U.S.P.Q.2d 1945 (Fed. Cir. 2002).

All-Dental argued that the failure to recite "an original unidentified mass" in the specification meant the term lacked sufficient written description for the requirements under 35 U.S.C. § 112, first paragraph, and was therefore new matter. However, the court held that the failure of the specification to specifically mention a limitation that later appears in the claims is not a fatal one when one skilled in the art would recognize upon reading the specification that the new language reflects what the specification shows has been invented.

Moreover, All-Dental argued that the failure to define the term "original unidentified mass" in the specification meant that the requirements under 35 U.S.C. § 112, second paragraph, for "definiteness" had not been met. Advantage argued that, while the meaning of the phrase "original unidentified mass" was neither facially apparent nor defined in the patent specification, the prosecution history clarifies the phrase to mean any shape different from a complete impression tray. Accordingly, the court held that the prosecution history can be

relied upon to clarify the claim meaning and hence provide definiteness.

In the present application, Applicants disclose heat presses are a non-preferred embodiment. It is proper for Applicants to claim their non-preferred embodiment.

Applicants further point out that the invention claimed does not have to be described in *ipsis verbis* in order to satisfy the description requirement of § 112, first paragraph. In re Lukach et al., 169 USPQ 795, 796 (CCPA 1971). To satisfy the written description requirement of 35 U.S.C. § 112, first paragraph, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991).

Importantly, a patent specification must contain a written description of the invention sufficient to "allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed." Gentry Gallery, Inc. v. Berkline Corp., 134 F.3d 1473, 1479, 45 USPQ2d 1498, 1503 (Fed. Cir. 1998) (quoting In re Gosteli, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989)).

In the present instance, the background of the invention explains that commercial heat presses are costly and inconvenient. It is true that the use of a hand iron, for instance in connection with the presently claimed method, reduces the expenses associated with the heat press. The issuance of the parent application Serial No. 09/995,681, now U.S. Patent No. 6,638,682 relates to the use of a hand iron. However, the use of a hand iron is simply one embodiment which is disclosed in connection with the present method. Those of skill in the art fully understand that the possession of the invention with respect to a hand iron necessarily implies the possession of the invention with respect to the heat press.

The importance of the last step in the present method is to provide sufficient heat and pressure to drive the coatings into the receptor element. Those of skill in the art understand, at the time of filing the present application, that Applicants were in possession of not only the use of a hand iron, but also the use of a heat press. In fact, any known means for applying heat and pressure is possessed, and therefore has sufficient written description in the present specification.

The case of Gentry Gallery, 45 USPQ2d 1498 (Fed. Cir. 1998) was discussed above.

Gentry involved a patent that related to two recliner seats facing the same way within one sectional sofa by having a fixed console between them, which contains the controls for the recliners. Prior to this invention, two recliners within a typical sectional sofa had to face different directions because the controls were in the armrests at the outer edges of the L shaped sectional. The Federal Circuit determined that the location of the controls for the recliners had to be on the fixed console because that was the invention contemplated. Gentry, 134 F.3d at 1480, 45 USPQ2d at 1503. Accordingly, when one of the claims did not specify this location restriction, this court determined that it was lacking an essential element of the invention and therefore violated the written description requirement of 35 U.S.C. § 112, first paragraph.

It is important to fully understand the scope of the Federal Circuit's holding in Gentry. Gentry should only be applied when the omitted limitation is an important or critical part of the invention, distinguishing it from prior art. In fact, the Federal Circuit explained that Gentry "considers the situation where the patent's disclosure makes crystal clear that a particular (i.e., narrow) understanding of a claim term is an 'essential element of [the inventor's] invention'." Johnson Worldwide Assoc., Inc. v.

Zebco Corp., 175 F.3d 985, 993, 50 USPQ2d 1607, 1613 (Fed. Cir. 1999).

For instance, in Gentry, the court's determination that the patent disclosure did not support a broad meaning for the disputed claim terms was premised on clear statements in the written description that described the location of a claim element, the "control means," as "the only possible location" and that variations were "outside the stated purpose of the invention." Gentry, 134 F.3d at 1479, 45 USPQ2d at 1503.

Applicants submit that the present situation does not rise to the level of Gentry. In Gentry, there were clear statements that the only possible location for the controls for the recliners had to be on the fixed console. In fact, evidence indicated that the inventor in Gentry did not even contemplate placing the controls elsewhere. Johnson Worldwide characterized Gentry as relating to the situation where the patent's disclosure makes "crystal clear" that a particular (i.e., narrow) understanding of a claim term is an "essential" element of the inventor's invention."

In contrast, the present specification does not contain "crystal clear" statements that the technique of transfer using a "hand iron" is an essential element of the invention. The use of a hand iron is disclosed in conjunction with the claimed method, but

this is simply the disclosure of one embodiment or a preferred example. Applicants should not be limited to a single embodiment. The statements from the description of the preferred embodiment are simply that—descriptions of a preferred embodiment. Absent a clear disclaimer of particular subject matter, the fact that the inventor anticipated that the invention may be used in a particular manner does not limit the scope to that narrow context. See Teleflex, 299 F.3d at 1328, 63 USPQ2d at 1382-83; Catalina Mktg. Int'l, Inc. v. Coolsavings.com, Inc., 289 F.3d 801, 809, 62 USPQ2d 1781, 1785 (Fed. Cir. 2002).

Further, the present facts do not involve a situation where the inventors failed to contemplate the use of anything other than a hand iron to achieve the presently claimed transfer. The present inventors simply contemplated the use of a hand iron as being more cost effective than other sources of heat and pressure, for instance a heat press.

Also, cost effectiveness is not the only disclosed advantage of the present transfer method. Cost effectiveness factors into the use of hand iron; however other advantages of the present transfer process exist which are unrelated to nature of the source of the heat and pressure.

At page 18, line 7 of the present specification it is disclosed that by using the present transfer method "[a]n easy and complete peel of paper will result." The specification goes on to explain that:

The cause for the ease and totality of the paper release is the result of the coatings first having been removed from the support sheet which had to have been thicker, more steady, and a restriction of heat permeability to carry the coatings then the printing process. (page 18, lines 8-13).

Another advantage of the present method is that it is not necessary to print the image in reverse on the transfer media so that it will appear correctly during a conventional transfer wherein the support is peeled after ironing. As disclosed in a Comparative Example of the present invention, such "reverse" printing is required in such a transfer. See Comparative Example, in particular disclosure at page 48, lines 24-31 of the present specification. However, it is immediately apparent that such "reverse" printing is unnecessary in the presently claimed method since the peeled and imaged transfer media need not be placed face down, but rather face up on the receptor element. This advantage is unrelated to the method of applying heat or pressure and this is fully understood by those of skill in the art.

Applicants respectfully submit that those of skill in the art fully understand that Applicants were in possession of the

invention as claimed at the time of filing. As such, the Examiner is respectfully requested to withdraw this rejection. Further, as discussed above, Applicants submit that the present specification and claims are distinguished from cases such as Gentry, since there is no "crystal clear" indication that the use of a hand iron is an essential element of the invention.

Accordingly, in view of the remarks hereinabove, the rejection of the claims under 35 U.S.C. 112, first paragraph, should be withdrawn by the Examiner.

Favorable action on the merits is respectfully requested.

Obviousness-Type Double Patenting

The Examiner has rejected claims 1-16 under the judicially created doctrine of obviousness-type double patenting as being obvious over claims 1-16 of USP 6,638,682. A Terminal Disclaimer relating to USP 6,638,682 (the parent application) was previously approved. See Advisory Action dated December 8, 2004. Accordingly, this rejection is moot. Withdrawal thereof is respectfully requested.

If the Examiner has any questions or comments, please contact Craig A. McRobbie, Reg. No. 42,874 at the offices of Birch, Stewart, Kolasch & Birch, LLP.

Appl. No. 10/628,491

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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